

Notice of Allowability

Application No.

10/056,099

Examiner

Daniel J Petkovsek

Applicant(s)

KANESHIRO ET AL.

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment received November 7, 2003.
2. ☒ The allowed claim(s) is/are 1-20.
3. ☐ The drawings filed on January 22, 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**


7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No. _____ | 7 <input type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |


AKM ENAYET ULLAH
PRIMARY EXAMINER

DETAILED ACTION

This office action is in response to the amendment received November 7, 2003. In accordance with the amendment, claims 1, 3, 11, and 13 have been amended.

Oath/Declaration

1. The declaration received October 31, 2003 is objected to and has not been considered, because of the following missing statements: the inventor must make/sign the declaration, unless a petition under 1.42, 1.43, or 1.47 is made for the attorney of record, the prior invention must be stated as not established in any country other than the U.S., a NAFTA country, or WTO member country, and a statement in the declaration must be made that a reduction of practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference was made (see *MPEP 715: 37 CFR 1.131*).

Allowable Subject Matter

2. Claims 1-20 are allowed. The following is an examiner's statement of reasons for allowance: the relevant prior art does not teach or reasonably suggest the amended (amendment received November 7, 2003) material in which "providing the integrated circuit includes providing photosensitive devices therein for providing feedback for controlling the opto-electronic element". The closest prior art of record (Ouchi et al. '286, Boudreau et al. '399) does not explicitly teach or reasonably suggest that the integrated circuit (IC) contains photosensitive elements. Both Ouchi et al. '286 and Boudreau et al. '399 have the IC element connected to the opto-electronic element by electrical connections, and as such it is suggested that electrical sensing (not photosensing) for feedback is done within the IC based on electrical signals (not optical signals) used in the opto-electronic element.

Art Unit: 2874

Rosenberg et al. U.S.P. No. 6,203,212 teaches a fiber optical engine comprising: an optical element 42 having an optical substrate 44 and optics, an opto-electronic element 48 aligned with the optics, an integrated circuit 50 for controlling the element, in which photosensitive devices are therein the IC to provide feedback for controlling the opto-electronic element 48. Rosenberg et al. '212 does not teach or reasonably suggest an electrical substrate secured to the optical element 42.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J Petkovsek whose telephone number is (571) 272-2355. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (703) 308-4819. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9321.



Daniel Petkovsek
January 21, 2004



AKM ENAYET ULLAH
PRIMARY EXAMINER